

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Nadine BURTON et al.) Confirmation No.: 8062
Application No.: 10/712,265) Group Art Unit: 3761
Filed: November 14, 2003) Examiner: I. Treyger
For: MEDICAL VACUUM ASPIRATION)
DEVICE HAVING REMOVABLE)
VALVE HOUSING (as Amended))

Commissioner for Patents

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action dated June 9, 2009, Applicants respectfully request a pre-appeal brief review of the pending rejections. A Notice of Appeal having a fee payment authorization therein is filed concurrently herewith. Applicants' arguments follow.

Claims 1-15 and 17-28 are pending.

The Rejection of Independent Claim 28

Claim 28 stands rejected based on a combination of Marie, Nettekoven, and Norelli. Claim 28 is directed to a medical vacuum aspiration device, including an aspiration syringe, a cannula, and a valve with various components. Marie relates to a handpiece for a surgical aspiration and irrigation device. Nettekoven relates to a tri-tubular suction irrigation device. As the Office Action concedes, neither Marie nor Nettekoven disclose an aspiration syringe.

The Office Action relies upon Norelli for an aspiration syringe. Norelli is directed to a safety cover for syringe needles. Neither the needle nor the syringe barrel in Norelli is sized or adapted in any way to couple to the aspiration/irrigation devices disclosed by Marie and Nettekoven. Rather, the syringe barrel connects to a needle and a needle safety cover. For at least this reason, the proposed combination of Marie and Nettekoven with Norelli is the product of impermissible hindsight.

Furthermore, Claim 28 recites that the valve includes "a removable cap that connects the first and second housing portions" and "resilient tubing ... coupled to the aspiration syringe and the cannula." For the reasons discussed in more detail below, Marie and Nettekoven fail to

disclose a valve having a “removable cap” as recited in Claim 28. Likewise, Marie and Nettekoven fail to disclose “resilient tubing removably held by the valve housing, the tubing coupled to the aspiration syringe and the cannula.” Norelli fails to make up for these deficiencies.

The Examiner asserts that Marie discloses that end component 8 and end connector 31 are made of “plastic material” and alleges (without any support) that the plastic material is inherently resilient. The Examiner is mistaken. First, Marie discloses that the shells, end components, and joining pieces can be made of a synthetic material. Marie does not disclose that these elements are resilient. In fact, Marie distinguishes between the “flexible conduits 15 and 16” and the connector 31, suggesting that the connector 31 is not resilient. Further, the end component 8 and end connector 31 are disclosed as being made of the same material as the “shell.” This suggests a brittle structure.

Moreover, for inherency to apply, it must be “clear that the missing descriptive matter is necessarily present in the thing described in the reference.” *See MPEP §2131.01(III) (quoting Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991)).* The Examiner cites no evidence that synthetic materials or plastics are inherently resilient. Many common objects are made of hard plastics that are not “resilient.” For example, polystyrene is a “rigid clear thermoplastic polymer that can be molded into objects or made into a foam used in insulation and packaging.” American Heritage College Dictionary (3rd. ed.) at 1061; *See also*, “polystyrene”, Encyclopedia Britannica On-Line (describing *polystyrene* as “hard”, “stiff”, and “brittle”). Materials characterized as rigid, stiff, hard, and brittle are clearly not “resilient.”

For these reasons, Applicants submit that the rejection of claim 28 is improper and should be withdrawn.

The Rejection of Claims 1, 2, 5-14, and 27 Should Be Withdrawn

Independent claim 1 stands rejected based on the combination of Marie and Nettekoven. Marie. Applicants respectfully traverse the rejection of Claim 1 because the combination of Marie and Nettekoven lack each of the claimed features. In particular, Claim 1 recites a valve including “a removable fluid conduit having a first end for attaching to the aspiration cylinder and a second end for attaching to a cannula” and “a removable cap that connects the first and second housing portions.” This combination of features is not disclosed in Marie and Nettekoven, even if these two references were combined as proposed in the Office Action.

The Office Action relies solely upon Marie for disclosure of a “removable cap” as recited in Claim 1. In particular, the Office Action attempts to equate the joining piece 30 of Marie to the “removable cap” recited in Claim 1. However, Marie does not disclose that the joining piece is removable. Rather, Marie discloses that the joining piece 30 and the end component 8 are joined by “the type of snap fitting that cannot be undone.” (Col. 3, lines 29-33.) As shown in Fig. 5, the snap fitting connection between joining piece 30 and end component 8 is made at the interior of these components and, thus, is inaccessible. Accordingly, the joining piece 30 cannot reasonably be considered a “removable cap,” as recited in Claim 1. In response, the Examiner asserts that “anything mechanically connected can be disconnected,” which simply ignores the text of Marie and renders the word “removable” meaningless. Moreover, the Office Action cites no evidences and offers no explanation as to how or why making the joining piece 30 removable would have made operation more convenient.

In addition, the Examiner attempts to equate the “removable fluid conduit” to the end components 8, the longitudinal conduit 15, and the tubular connector 31 of Marie. However, Marie does not teach or suggest that any of these elements are removable. In fact, connector 31 is part of the joining piece 30. (See Figs. 3 and 5; and col. 5, lines 31-33.) As noted above, the joining piece 30 is not properly considered removable.

Claim 1 recites the “removable fluid conduit” and the “removable cap” as separate elements. The Office Action alleges that the same structure – namely the joining piece 30, which includes the tubular connector 31 – is both the removable fluid conduit and the removable cap. The joining piece 30 of Marie cannot be both the fluid conduit and the cap of Claim 1. The Examiner responds that the joining piece 30 and the end connector 31 are “separate elements of the same assembly,” apparently because they are identified with different reference numerals. Such explanation is incomplete at best. It does not address much less justify the interpretation of Marie that part of the joining piece is allegedly the “removable cap” and part of the joining piece is combined with other structure to become the separately recited “fluid conduit” of claim 1.

For at least these reasons, the combination of Marie and Nettekoven fails to disclose each of the features of Claim 1. For at least these reasons, the rejection of Claim 1 should be withdrawn.

While not addressed in the Office Action, Marie also teaches away from the combination proposed by the Examiner. Marie states that shells 3 and 4 are fitted together by “snap locking

means 6 and 7", which as shown in Figs 1 and 5 are provided on the inside of the device and thus are not accessible. (Col. 4, lines 50-53). It is apparent that once the shells 3 and 4 are locked together with no reasonable way to separate them. Moreover, as noted above, Marie indicates that the joining piece 30 and the end components 8 are joined with "the type of snap fitting which cannot be undone." (Col. 3, lines 29-33; *see also*, col. 6, lines 39-41.) Thus, Marie teaches away from any design "that permits the interior of the housing to be accessed" as alleged in the Office Action.

In addition, the rationale for the proposed combination of Marie and Nettekoven is that it would have been "simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," as alleged in the Office Action. (citations omitted.) This is not the case. The Examiner *adds* the hinged connection from Nettekoven to the handpiece of Marie. Thus, the situation is not one of substituting one known element for another. Further, Marie was applied for and patented after Nettekoven and consequently cannot be considered a "piece of prior art ready for improvement" by the teachings of Nettekoven. In response, the Examiner states that both Marie and Nettekoven are prior art to the present invention. However, this does not address the lack of rationale for the proposed combination.

For at least the reasons discussed above, the rejection of Claim 1 should be withdrawn. Further, because the claims that depend from Claim 1 incorporate the features of Claim 1, the rejection of dependent claims 2, 5-14, and 27 should be withdrawn.

While Applicants do not acquiesce to the correctness of the rejections of the dependent claims, it is further noted that rejections of dependent Claims 6-8 are improper for the reasons advanced in Applicants' previous response. In addition, Applicants point out that the elements that the Examiner alleges can be formed together as an integral component are disclosed in Marie as being made of different materials and also have different functions. There is no basis for forming the elements together as an integral component.

The Rejection of Claims 3, 4, 25 and 26 Should Be Withdrawn

Claims 3, 4, 25, and 26 depend from independent Claim 1. The Office Action relies upon the combination Marie, Nettekoven, and Moutafis to reject Claims 3, 4, 25, and 26. However, Moutafis does not cure the deficiencies noted above with respect to independent Claim 1.

Accordingly, the rejection of Claims 3, 4, 25, and 26 should be withdrawn at least for the reasons discussed above in connection with Claim 1.

The Rejection of Independent Claim 15 and Its Dependent Claims

Claim 15 is patentable over the prior art of record. For reasons similar to those discussed above, Marie and Nettekoven fail to disclose, among other things, a valve having “a removable cap that connects the first and second housing portions.” These references also fail to disclose the claimed “flexible fluid conduit.” At least for these reasons, the rejection should be withdrawn and Claim 15 and its dependent claims allowed.

The Provisional Obviousness-Type Double Patenting Rejection

Claims 1-15 and 17-28 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting based on a co-pending continuing application. The co-pending application is allowed, but pending. Once one of the applications issues, Applicants plan to file a terminal disclaimer.

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EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. §1.1 36(a)(3).

Respectfully submitted,

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Dated: December 9, 2009

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